

**\* \* REASONS FOR RESPONSE AND REMARKS \* \***

Applicant wishes to acknowledge with appreciation the Examiner's analysis and efforts in examining this application.

The Examiner rejected Claims 1, 2, 3, 10, 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Yang in view of Bontomase and Taylor. The Examiner asserts that Yang discloses the invention substantially as claimed, but lacks a non-light-producing insert. The Examiner contends that in order to maintain the "regulation" status of the club head and to avoid altering the performance of the head, it would have been obvious to replace the light-producing-insert with a non-light-producing insert, since it has been shown to be old in the art to modify a club head putter for practice purposes and to further transform the putter into an arrangement that is intended for regulation play. The Examiner further contends that in this regard, the patent to Bontomase is cited to show that the practice sighting element held within a cavity within the head is "replaced" with a core that in this case is inverted so that there is no depreciable weight shift in the putter head while at the same time making the putter head legal for regulation play.

To establish a *prima facie* case of obviousness, as is the case with this present rejection, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references, or to combine the references' teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See also MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

Specifically regarding motivation and likelihood of success, hindsight reconstruction cannot be used to pick and choose among isolated disclosures in the prior art to

depreciate the claimed invention. *In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). *Panduit Corp. v. Dennison Manufacturing Co.*, 227 USPQ2d 337, 343 (CAFC 1985). *In re Shuman*, 150 USPQ 54, 57 (CCPA 1966). Motivation and likelihood of success must, therefore, exist in the prior art references themselves, and not in the presently claimed invention.

Applicant respectfully requests reconsideration of the Examiner's rejection of Claim 1 for obviousness based upon Yang in view of Bontomase and Taylor. Upon review of Yang, no motivation is found to make laser pointer 2 "removably received" by recessed chamber 11 as required by Claim 1. The specification language of Yang only describes how laser pointer 2 functions once inserted into recessed chamber 11. Yang describes laser pointer 2 as comprising an outside annular flange 23 raised around its periphery. Fig. 2 shows that outside annular flange 23 is forced into engagement with an inside annular groove 111 in recessed chamber 11, allowing laser pointer 2 to rotate. Steel ball 242 is utilized to hold laser pointer 2 into position when steel ball 242 is received by recessed hole 112 in recessed chamber 11. The Yang specification does not describe how laser pointer 2 is to be removed from recessed chamber 11 once outside annular flange 23 is forced into engagement with inside annular groove 111. Indeed, Yang states in column 2, lines 5-7 that laser pointer 2 can be pivotally fastened by a rivet in the bottom sidewall of the recessed chamber of the head, or fixedly mounted in the recessed chamber (col. 2; lines 35-39). Clearly, there is no motivation or suggestion in Yang regarding removability of laser pointer 2.

As pointed out by the Examiner, Bontomase fails to disclose an actual replacement insert to convert a practice putter to one qualified for regulation play. Bontomase merely discloses a putter having a core 16 that includes a level 26 for practice putting. Core 16 is threaded such that it can be screwed into putter blade 10 for use of level 26, or inverted and placed into cavity 14 when a regulation-style putter is desired. Bontomase also discloses the use of weight chips 18 to manipulate the weight of the putter blade 10. Applicant respectfully submits that Bontomase does not disclose a manner in which laser pointer 2 of Yang could be successfully removed and rendered non-operable. Yang modified in accordance with threaded core 16 of Bontomase (i.e., the body of laser pointer 2 being threaded) falls short of teaching or

suggesting all the claim limitations. Such a modified structure would not include the “non-light producing insert” of Claims 1 and 14.

While inverting laser pointer 2 of Yang could result in rendering pointer 2 inoperative during actual play (i.e., if care is taken so that the lense would not end up aligned with slot 13 when inverted, and so that switch 21 would not be activated by contact with the bottom of recess chamber 11), such modification would seem to accomplish no more than merely turning the device off with on/off switch 21, which is specifically located on the “top side” of laser pointer 2. Indeed, it would seem far easier to render laser pointer 2 inoperative by simply rotating the device beyond the range of adjustment provided by recessed holes 12 and ball 242 to position lense 22 away from slot 13. Either would seem preferable to modification according to Bontomase. Accordingly, Applicant respectfully submits that the only apparent motivation for making a modification of Yang per Bontomase is an improper application of hindsight in an attempt to find the elements of Applicant’s claims in the prior art.

The Examiner apparently recognizes the deficiencies of the Yang/Bontomase combination, given the reliance upon Taylor in rejecting the subject claims. The Examiner states that Taylor “is cited to show in an analogous fashion that the tip for a cue that has been altered for practice is reverted back to its original design” ... and that “the modification creates no appreciable change in the weight, shape or balance of the cue.” As to Claim 13, the Examiner states that “the skilled artisan would have found it obvious to provide any convenient structure for holding the insert within the club head during use.”

Applicant respectfully believes that Taylor also fails to disclose the necessary features to make Claim 1 obvious when combined with Yang and/or Bontomase. Taylor merely discloses a replacement pool cue end which is equipped with a laser module, as shown in Figs. 1 and 2, used in place of a “traditional” cue end (14 in Figure 6). Even by analogy, nothing in Taylor combines with Yang and Bontomase to show how laser pointer 2 of Yang is removable and replaceable. An analogous modification of Yang (or the Yang/Bontomase combination) would be the provision of a replacement head 1 of “traditional” design for attachment to the

putter shaft. This combination, therefore, fails to remedy the deficiency of the Yang/Bontomase combination (i.e., there is no non-light producing element configured to be selectably received within a cavity in the golf club head in place of the light-producing insert), as required by independent Claims 1 and 14.

Regarding Claim 13, Applicant respectfully requests reconsideration of the Examiner's rejection in light of the disclosure provided by Bontomase. The Examiner has stated that a skilled artisan would have found it obvious to use any convenient structure for holding the insert within the club head during use. However, as discussed earlier, threaded core 16 of Bontomase has no mechanism for a laser pointer to remain aligned with a club face even if the threaded core 16 included the laser pointer. The snap fit provides alignment for the laser pointer upon insertion. This distinction shows that the structure chosen to hold the insert within the club head is not an obvious choice, and should, therefore, not be rejected on such grounds.

In summary, Applicant respectfully submits that the Yang, Bontomase, and Taylor references cannot be combined to render Claim 1 obvious without using improper hindsight reconstruction. Even then, the combination falls short. Yang neither shows nor suggests that laser pointer 2 be removed and replaced with a different insert to qualify a golf putter for regulation play. Bontomase discloses no motivation to make laser pointer 2 of Yang removable and replaceable with a separate, non-light-producing insert, nor does Taylor. Neither of the references suggest or provide the necessary motivation for combining them in order to make Claim 1 obvious under § 103(a). Based on the foregoing analysis, Applicant respectfully believes that Claims 1, 2, 3, 10, 12, and 13 as written are allowable over the Examiner's rejection.

The Examiner rejected Claims 4-9, 14, 15, 17, 18, 19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Yang in view of Bontomase, Taylor, Cloud, and Stock. The Examiner asserts that Yang in view of Bontomase and Taylor has been discussed and that "[t]o have further modified the device in the cited art reference to Yang by including a prism and a target that reflects the laser beam initiated from the putter head so that a golfer may have a

distinct line of sight (i.e., path of light to follow) between the putting face and the intended target would have been obvious in view of the patent to Stock, which shows it to be old in the art to provide a laser apparatus with a prism for [sic] to target the highly directional beam of light from the putter face to the target.”

Applicant respectfully requests reconsideration of the Examiner’s rejection of Claims 4-9. Arguments set forth above in connection with Yang, Bontomase, and Taylor are applicable, and will not be repeated. Stock in combination with Yang, Bontomase, and Taylor fails to make obvious that which is claimed in Claim 6. Stock only shows a laser light beam 38. Fig. 1 of Stock clearly shows beam 38 to be unidirectional such that it is projected through the air straight onto target 34. Claim 5 calls for a prism to transmit the light, while Claim 6 calls for the prism to columnate a light beam such that the claimed beam forms a line on a surface. Stock does not disclose a manner in which to columnate beam 38 on a surface through use of a prism, thereby allowing the path to the cup to be shown. For these reasons, Applicant respectfully believes Claims 5 and 6 are in condition for allowance.

The Examiner further states that the use of a target to reflect the laser beam, as required by Claims 7, 9 and 14, and, more specifically, the use of a target with markings as required by Claim 15, would have been obvious in view of Cloud. The Examiner states that, specific to Claim 4, to have positioned a transparent material over aperture 13 in the Yang device merely to protect the laser light or diode or structure behind the face from damage that might have occurred during an impact with a golf ball would have been obvious and would have further involved nothing more than common sense.

In light of the foregoing discussion regarding Claim 1, Applicant respectfully requests reconsideration of Claims 7, 9, 14, and 15. As previously stated, Applicant respectfully believes that Yang, Bontomase, and Taylor fail to disclose that which is claimed in Claim 1. Cloud shows a light beam emitted from face 18 onto target 40 as shown in Fig. 2. Cloud fails to contribute to the previously discussed combination of Yang, Bontomase, and Taylor, in order to make independent Claims 1 and 14 obvious.

Regarding Claim 4, the Examiner's "common sense" position fails to identify any references showing such transparent material over an aperture. Applicant respectfully believes that without a reference showing this feature Claim 4 should be allowed. Applicant respectfully believes, therefore, that Claims 4, 7, 9, 14, and 15 are allowable as written.

The Examiner rejected Claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Yang in view of Bontomase, Taylor and Vargo. The Examiner states that to have further modified the device in the cited art reference to Yang by locating the aperture associated with the light-producing-insert closer to the midpoint of the ball-striking face in order to help a golfer focus on lining up the center or sweet spot of the club head with an intended target would have been obvious in view of the patent to Vargo.

In light of the foregoing discussion regarding Claim 1, Applicant respectfully requests reconsideration of Claim 11 as written. Even with the addition of Vargo, the combination of references fails to make Claim 11 obvious for the reasons previously discussed in connection with Claim 1. Applicant, therefore, respectfully believes that Claim 11 is in condition for allowance.

The Examiner rejected Claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Yang in view of Bontomase, Taylor, Cloud, Stock and Gross. The Examiner asserts that to have further modified the Yang device by including a target that is accommodated within a golfing hole so that the golfer's sight is focused on the end target and not perhaps on an intermediate location somewhere ahead of the golfing hole would have been obvious in view of the patent to Gross, which shows it to be old in the art to include a reflective target 64 mounted to a flagstaff that is to be mounted within a golfing hole. The Examiner concludes that the arrangement provides a light source to focus a light path from the striking face to the reflective target.

Applicant respectfully believes that Claim 16 is allowable over the Examiner's rejection. Reflective target 64 of Gross is shown to be positioned on a flagstaff. Typically, however, a flagstaff is not positioned in the cup when a golf ball is putted from the green.

Practicing with the flagstaff in the cup would, therefore, be counter to that of practicing under regulation-like conditions. The subject matter claimed in Claim 16 allows a golfer to practice under regulation-like conditions and is thus distinguished from Gross. Applicant, therefore, respectfully believes Claim 16 is in condition for allowance.

In light of the previous discussions regarding Claims 5 and 6, Applicant respectfully believes Claims 17-19 as written are in condition for allowance. In light of the previous discussion regarding Claim 13, Applicant respectfully believes Claim 20 as written is in condition for allowance.

The Examiner rejected Claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Vargo in view of Au. The Examiner asserts that although Vargo does not specifically reference a non-light-producing insert, it is well recognized that putters are often modified for training purposes and may include the introduction into a cavity within the club body of at least one insert or a plurality of diverse inserts to suit the practice needs of a golfer. The Examiner states that, in this regard, Au is cited to show the “commonness” of including multiple inserts within a club head for practice purposes, whereby the golf club head may be modified as needed by a golfer. Further, the Examiner states that it would have been obvious to modify the Vargo device by simply including or adding another type of insert within the head, the motivation being to provide a further practice putting head scenario.

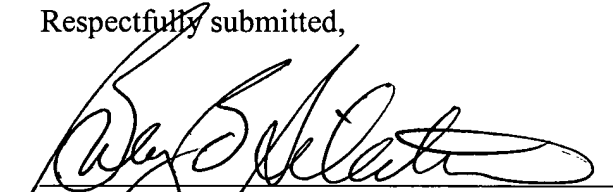
Applicant respectfully requests reconsideration of the Examiner’s rejection of Claim 1 as being unpatentable over Vargo in view of Au. The combination of these references fails to include that which is claimed by Claim 1. Vargo discloses the use of a non-removable cylindrical laser 52 located in the putter head. Au discloses the use of “weight distribution” for manipulating the swing weight and sweet spot of a putter. Combining Vargo and Au, as the Examiner has attempted, only produces a putter having a laser along with the ability to manipulate the swing weight and sweet spot of the putter head. The combination of Vargo and Au fails to produce a non-light-producing insert which replaces a light-producing insert. Applicant respectfully believes that Claim 1, as written, is in condition for allowance.

Serial No. 10/659648  
Docket No. 35109-82668

If, upon consideration of the above, the Examiner should feel that there remain outstanding issues in the present application that could be resolved, the Examiner is invited to contact Applicant's patent counsel at the telephone number given below to discuss such issues.

A Petition for Extension of Time under 37 C.F.R. §1.136 accompanies the filing of this document. To the extent necessary, a petition for an additional extension of time under 37 C.F.R. § 1.136 is hereby made. To the extent additional fees are required, please charge the fees due in connection with the filing of this paper, including additional extension of time fees, to Deposit Account No. 02-1010 (35109/82668) and please credit any excess fees to such deposit account.

Respectfully submitted,



---

Bobby B. Gillenwater  
Reg. No. 31,105  
Direct Line (260) 425-4649